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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09 847,892	05 02 2001	Joseph F. Walsh	35006-00019CIP	7516

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SUMMIT LAW GROUP
1505 Westlake Ave., North
Seattle, WA 98019

EXAMINER

LE, THIEN MINH

ART UNIT	PAPER NUMBER
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2876

DATE MAILED: 11 20 2002

Please find below and or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/847,892

Applicant(s)

BOYDSTON ET AL.

Examiner

Thien M. Le

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED. (35 U.S.C. § 133)
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 03 September 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 1-86 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) 24-63 is/are allowed.
- 6) ☐ Claim(s) 1-23, 64-86 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other: _____

DETAILED ACTION

The response filed on 9/3/2002 has been received. Claims 1-86 remain presented for examination.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) do not apply to the examination of this application as the application being examined was not (1) filed on or after November 29, 2000, or (2) voluntarily published under 35 U.S.C. 122(b). Therefore, this application is examined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

Claims 1-6, 11-15, drawn to the method and apparatus claims 64-68 and 73, are rejected under 102(e) by Messenger (Messenger – 5,276,680; newly cited).

Messenger discloses a wireless coupling of devices to wired network. Specifically, Messenger discloses the use of low-powered, battery-powered hand-held unit 18 which are coupled by a wireless link to a communication network. According to Messenger, the wireless coupling devices 18 (handheld) can be used in a POS

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environments. In the back ground of the invention, Messenger discloses that it is sometimes desirable to couple a portable device to such a network without requiring wiring to a router or to the primary cable medium. For example, it might be advantageous to permit a personal computer or terminal to be operated anywhere in an office complex to access data from a mainframe computer. In an automated system for identifying grocery prices, a battery-operated hand-held unit might be used to scan bar-codes identifying a particular product on display shelves. The scanned data can then be transmitted to a central computer that returns the price currently recorded and applied to purchase of the product at cash registers, for comparison with displayed prices. A battery-operated hand-held unit may also be used during physical inspection of inventories, allowing an individual to identify types and quantities of products and to transmit such data to a central computer that updates inventory records.

With regarding to claim 1, Messenger's teaching (as have been discussed above), comprises at least one hand-held unit 18. The hand held scanning unit 18 can be connected to a remote server (or a host computer) for transmitting requests and receiving responses. The information received from the remote server can prices, quantities, and/or types of the products. As can be seen, Messenger discloses the claimed invention.

Regarding claim 2, see the discussions regarding claim 1. Specifically, Messenger discloses use of product identification bar codes.

Regarding claim 3, typical handheld scanning devices would include a key pad and thus would meet the limitation set forth in this claim.

Regarding claim 4, Messenger discloses the use of a RF link.

Regarding claims 5-6, 11, 12-15, see the discussions above.

Regarding claims 64-68, 73, see the discussions above.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to

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consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 7-10, 16-23, 69-72, and 74-86 are rejected under 35 U.S.C. 103(a) as being obvious by Messenger (5,276,680; cited above).

Regarding claims 8-10, 16-23, 69-72, and 74-86, the system as taught by Messenger, as has been discussed above. The claims differ in calling for various variations and combinations including: memory, card reader, low-power proximity detector, magnetic card, audio input/output ports, etc. It would have been obvious to incorporate these features in the system as taught by Messenger. The use of each and some combinations of these features in bar code scanning system are known and have been incorporated in commercially available scanners. For example, the use of proximity detector has long been used and developed by many scanner manufacturers, including: Symbol Technologies; Spectra Physics Corp.; Norand; Metrologics; etc. Further, magnetic card reader and audio input/output ports have been incorporated in self-checkout and POS environments. Without any unexpected result, the modifications are merely considerations which are well within skill levels and expectations of an ordinary skilled artisan.

Response to Arguments

Applicant's arguments with respect to claims 1-86 have been considered but are moot in view of the new ground(s) of rejection.

Allowable Subject Matter

Claims 24-63 are allowed.

The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to disclose handheld unit for transmitting requests and receiving responses to/from a server comprising:

A number of input components;

A processing component;

A transceiver;

A number of output components;

And having the features, functions and characteristics as recited in claim 24.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thien M. Le whose telephone number is (703) 305-350. The examiner can normally be reached on Monday - Friday from 7:30am - 4:00pm.

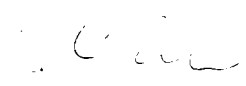
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (703) 305-3503. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 308-5841 for regular communications and (703) 308-7722 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0956.

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Le, Thien M.
Primary Examiner
Art Unit 2876
November 15, 2002